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OFFICE OF PETITIONS

In re Application :  
Anthony Nicholls :  
Application No. 09/644,937 :  
Filed: August 23, 2000 :  
Patent No. 7,110,888 :  
Issued: September 19, 2006 :  
Atty Docket No. 19455-002001 :

: DECISION ON APPLICATION  
: FOR PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF DECISON ON PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) AND REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed July 26, 2006. Patentees request that the determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred eighty-nine (189) days to five hundred eleven (511) days.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of three hundred nine (309) days.

On November 4, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is one hundred ninety-four (194) days. On December 5, 2005, Applicants timely<sup>1</sup> submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance

<sup>1</sup> Applicants filed the application for patent term adjustment together with the payment of the issue fee.

is five hundred eleven (511) days. The application for patent term adjustment was granted in part in a decision mailed on July 26, 2006. The decision stated that the patent term adjustment was one hundred ninety-five (195) days.

Patentees state that the patent is not subject to a terminal disclaimer.

On September 19, 2006, the application issued into Patent No. 7,110,888 with a patent term adjustment of one hundred eighty-nine (189) days. The Office determined a patent term adjustment of one hundred eighty-nine (189) days based on an adjustment for PTO delay of two hundred ten (210) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), one hundred eighty (180) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. 1.703(a)(2), fifty-nine (59) days pursuant to 35 U.S.C. 154(b)(1)(A)(iv) and 37 C.F.R. 1.703(a)(2), and one hundred fourteen (114) days pursuant to 35 U.S.C. 164(b)(1)(A)(iv) and 37 C.F.R. 1.703(a)(6), reduced by applicant's delays of ninety (90) and thirty-two (32) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), one hundred thirty-two (132) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. 1.704(c)(7), and one hundred twenty (120) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. 1.704(c)(10). The adjustments of 132, 59, and 120 days are at issue.

With respect to the adjustment of one hundred thirty-two (132) days, the Office mailed an Office action on September 10, 2002. Applicants filed a reply on March 10, 2003. However, the reply was not proper, and the Office mailed a Notice of Non-Responsive Amendment on June 30, 2003. The Notice required a substitute abstract beginning on a separate paper, as required by 37 C.F.R. § 1.72(b). Applicants filed a proper reply on July 21, 2003, and were assessed delay of one hundred thirty-two (132) days pursuant to 37 C.F.R. 1.704(c)(7).

Patentees argue that they should not have been assessed delay of one hundred thirty-two (132) days, asserting that the March 10, 2003 reply was a bona fide reply (as stated in the Notice of Non-Responsive Amendment), and that the Office's mailing of the Notice was a matter of formality, rather than substance.

The Office has stated that:

Section 1.704(c)(7) establishes submission of a reply having an omission (1.135(c)) as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

Submitting a reply having an omission requires the Office to issue an action under 1.135(c) and await and process the applicant's reply to the action under 1.135(c) before the initial reply (as corrected) can be treated on its merits.<sup>2</sup>

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<sup>2</sup> Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 1239 OG 14, 65 Fed. Reg. 54366 (Oct. 3 2000).

Furthermore, 37 C.F.R. 1.135(c) states that:

When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under §1.134 to supply the omission.

Accordingly, the Office considered that even if a reply was deemed to *bona fide*, nevertheless it could be deemed to have an omission. The Office did not distinguish between those omissions which involved matters of formality, versus those that involved matters of substance. In view thereof, the delay of one hundred thirty-two (132) days was properly accorded.

With respect to the fifty-nine (59) days of applicant delay, Applicants assert that the fifty-nine (59) days of PTO delay for the delay in mailing a Notice of Allowance should instead total one hundred ten (110) days. The Office mailed a Notice of Allowance to the correct address of record on September 14, 2005, and were assessed PTO delay of fifty-nine (59) days. The Office mailed a corrected Notice of Allowance on November 1, 2005, restarting the period for reply for purposes of paying the issue fee. The July 26, 2006 decision on application for patent term adjustment stated that the corrected Notice did not vacate the Notice of Allowance mailed September 14, 2005, and as such, the Office delay of fifty-nine (59) days was proper.

With the instant application for patent term adjustment, Patentees argue that as a matter of equity, they should not be penalized for the delay between issuing the two Notices of Allowance. Patentees argue that the Corrected Notice of Allowance set a new period for response, that they timely paid the issue fee within the time limit set by the Corrected Notice of Allowance, and that notice more was required of Applicants. Patentees argument has been carefully considered, but is not persuasive. Patentees are correct that insofar as avoiding abandonment of the application, Applicants were entitled to wait until the end of the period set by the Corrected Notice of Allowance before timely paying the issue fee. However, doing so did delay the issuance of the patent.

Lastly, one hundred twenty (120) days of Applicant delay accorded for the filing of a "STATEMENT OF SUBSTANCE OF INTERVIEW" on December 2, 2005. A Statement of Substance of Interview is not identified as one of the papers the filing of which the Director

has specifically deemed not to be a failure to engage in reasonable efforts under 37 C.F.R. §1.704(c)(10).<sup>3</sup> Nevertheless, under the circumstances of this case, it is concluded that the filing of applicants' "STATEMENT OF SUBSTANCE OF INTERVIEW" is not a failure to engage under 37 C.F.R. §1.704(c)(10). Accordingly, the assessment of one hundred twenty (120) days of applicant delay with respect to this filing is not warranted.

In view thereof, the correct determination of PTA at the time of issuance is three hundred nine (309) days (563 days of PTO delay and 254 days of applicant delay).

The \$200.00 fee set forth in 37 C.F.R. §1.18(e) has been charged to Deposit Account No. 06-1050, as authorized.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. § 254 and 37 C.F.R. § 1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **three hundred nine (309) days** subject to any disclaimers.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

*Kery Fries*

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<sup>3</sup> See Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. 111 (June 26, 2001).